

**REMARKS**

Entry of this amendment, reconsideration and withdrawal of all grounds of rejection, and allowance of the application are respectfully requested. Claims 1-8, as shown above, remain pending herein. Applicants have amended claims 1-5 as shown above. Support for the above changes are clearly found in the specification at page 3, lines 5-26.

(1) Claims 1-8 stand finally rejected under 35 U.S.C. §112, first paragraph, because the recitation that the second filler is present in sufficient quantity so as to transform radiation into heat and adsorb 99% of the information is allegedly non-enabling with undue experimentation. Applicants respectfully disagree and traverse this ground of rejection.

Although Applicants have clarified the recitation of claims 1 and 8 by this amendment, Applicants respectfully submit that the MPEP 2164.01(a) clearly advises that the factors to be considered include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill in the art;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples;
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

While the Final Office Action appears to focus in on factor (H), Applicants first respectfully respond that MPEP 2164.06(a) refers to the case of *United States v. Telectronics Inc.*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989) wherein the Court of Appeals for the Federal Circuit held that one embodiment and the method to determine dose/response was set forth in the specification, enablement existed, *despite the fact that \$50,000 and 6-12 months of experimentation were required*.

In the present Application, the specification does in fact disclose weight ratios of the first and second fillers to the rest of the security coating, ranges of percentage by weight of the coating, thicknesses, as well as examples shown in the drawings (particularly Fig. 3) and discussed at least at page 7, last two paragraphs that discuss *inter alia*, percentage by weight of TiN and TiO<sub>2</sub>, among other information. The amount of the second filler that would be required to transform radiation into heat and absorb at least 99% of infrared radiation in contact therewith of wavelengths in the range of about 800 to 1400 nm and is free of heavy metals provides the artisan with teachings that do not require “undue experimentation”. Thus, the Applicants meet all the enablement factors including those listed in items (G) and (H).

Applicants have amended claims 1 and 8 in accordance with some of the teachings clearly found on page 3 of the specification as well, and it is respectfully submitted that none of the instant claims are non-enabling.

Reconsideration and withdrawal of this ground of rejection are respectfully requested.

It is alleged in the Final Office Action that Lantz, although not disclosing anything with regard to the absorption of infrared information inherently meets the limitations by disclosing the same two powdery fillers.

However, it is respectfully submitted that Lantz does not disclose or suggest the amounts of the first and second powdery fillers to be used so as to transform radiation into heat and absorb at least 99% of infrared radiation.

Applicants are the first to discover that when at least about 99% of the infrared radiation is absorbed that the ability to use light and extract information from the SmartCard is effectively eliminated. This amount of infrared blockage is based on there being an amount of the second filler relative to the first filler that is not inherently disclosed by Lantz. There is no evidence to support this inherency.

Applicants also refer to MPEP 2141.02, which quotes *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237,243 (CCPA 1969), which held that:

[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the subject matter as a whole which should always be considered in determining the obviousness of an invention under 35 U.S.C. §103.

In light of the above, as Lantz fails to make any teaching or disclosure regarding amounts or ranges of powdery fillers and why a certain amount or range is important, it cannot be said that the any of the instant claims would have been obvious at the time of invention in view of the teachings of Lantz. Reconsideration and withdrawal of this ground of rejection are respectfully requested.

(3) Claim 4 stands rejected under 35 U.S.C. §103(a) over Lantz as applied to claim 1 and further in view of U.S. 4,243,427 to DiBugnara. Applicants respectfully traverse this ground of rejection.

Applicants respectfully submit that instant claim 4 is allowable at least for its dependence upon instant claim 1, which is believed to be allowable for the reasons previously indicated.

(4) Claim 5 stands rejected under 35 U.S.C. §103(a) over Lantz and DiBugnara as applied to claims 1 and 4 and further in view of Bearinger et al. (U.S. 6,144,106 hereafter “Bearinger”).

(5) Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) over Lantz in view of Gilberg et al. (U.S. 5,093,992, hereafter “Gilberg”). Applicants respectfully traverse this ground of rejection.

Applicants respectfully submit that claims 6 and 7 would not have been obvious to an artisan in view of Lantz and Gilberg at least because the combination fails even to disclose or suggest Applicants’ base claim.

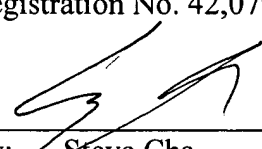
(6) Claim 8 stands rejected under 35 U.S.C. §103(a) over Lantz in view of Gilberg in view of Stafford et al. (U.S. 5,892,661, hereafter “Stafford”). Applicants respectfully traverse this ground of rejection, as the combination of references clearly fails to disclose or suggest at least the recitation that the second filler is present in a quantity of about an equal amount by weight as the first filler so as to transform radiation into heat and absorbs at least 99% of infrared radiation in contact therewith. Reconsideration and withdrawal of this ground of rejection are respectfully requested.

(7) Finally, Applicants wish to respond to the statement in the Office Action regarding structure versus function by stating that the instant claims do recite a patentably distinguishable structure that also functions in a way not disclosed or suggest by the references.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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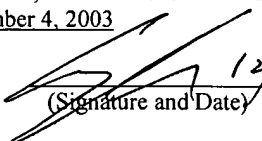
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